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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/917,710	08/26/97	BEDNARIK	D 1488.0450001
			EXAMINER

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HM11/0622

RECEIVED  
JUN 24 1998

DRAPER, G	PAPER NUMBER
ART UNIT	

1646  
DATE MAILED: 06/22/98

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☒ Claim(s) 1-19 is/are objected to.
- \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

Applicant Copy

Serial Number 08/917710

Art Unit 1646

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**Part III: Detailed Office Action**

**1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1646, Group 1640, Technology Center 1600.**

**2. Restriction Requirement:**

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, PhD., Supervisory Patent Examiner at Donald. Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. **Please limit the use of this dedicated Fax number to responses to Written Restrictions.**

A telephone call was made to Kimberlin Morely on 6-17-98 to request an oral election to the above restriction requirement, but did not result in an election being made.

Ms. Morely expressly requested a written restriction requirement.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 16, drawn to nucleic acid encoding IL-1 receptor Accessory molecule, vectors, host cells and recombinant method of making the protein, classified in classes 435 and 536, subclasses 69.5+ and 23.5.
- II. Claims 11-14, 17, drawn to the IL-1 receptor Accessory molecule, classified in class 530, subclass 351.
- III. Claims 15, drawn to antibodies to the IL-1 receptor Accessory molecule, classified in class 530, subclass 389.2.
- IV. Claim 19, drawn to a method of using the host cell to identify agonist and antagonist, classified in class 435, subclass 7.1+.

The inventions are distinct, each from the other because:

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the protein, as claimed, can be made by a materially different method such as by chemical synthesis, or its isolation from nature using various isolation/purification/chromatographic methods. Furthermore, the DNA, as claimed, can be used other than to make the encoded protein, such as its use as a probe, in gene therapy, or to make transgenic animals.

Inventions Group I and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the host cells, as claimed, can be used in materially different processes such as to express the protein as stated above, or they could be used in therapeutic or other diagnostic methods.

It is further pointed out that although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for multiple/different products, restriction is deemed to be proper because the products appear to constitute patentably distinct inventions. The inventive products of Groups I, II, and III are directed to products that are structurally, physically and functionally distinct and if determined to be patentable they would also be patentably distinct. Furthermore, these products are not required one for the other, nor are they required for each of the methods.

In a similar manner it is further pointed out that although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for multiple/different methods, restriction is deemed to be proper because the methods appear to constitute patentably distinct inventions. The inventive methods of Groups I and IV require the use of different steps/methods;

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Art Unit 1646

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elements/agents that are physically and functionally distinct; there are different starting elements and the final outcome/results are different for these different methods that cover various diagnostics and therapeutic methods; and if determined to be patentable they would also be patentably distinct. . Furthermore, these methods are not required one for the other, nor do they require each of the products.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications which are not co-extensive. And there are different issues for the search and examination of each group, which would be unduly burdensome, accordingly, restriction for examination purposes as indicated is proper.

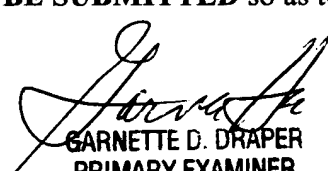
Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

**3. Advisory Information:**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Garnette D. Draper, Art Unit 1646, whose telephone number is (703) 308-4232**. Examiner Draper can normally be reached Monday through Friday, 9:30 A.M. to 6:00 P.M.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at telephone number (703) 308-0196.

**Official papers filed by fax for this "Pilot for Written Restrictions" should be directed to (703) 305-3704-which is a Fax machine specifically for this pilot.** Papers related to this application for election from the written restriction may be submitted to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). **NOTE:** If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. **NO DUPLICATE COPIES SHOULD BE SUBMITTED** so as to avoid the processing of duplicate papers in the Office.

  
GARNETTE D. DRAPER  
PRIMARY EXAMINER  
GROUP 1800



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

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TO EXAMINER:

ART UNIT:

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**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY  
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

**IN COMPLIANCE WITH 1096 OG 30**, THE FILING DATE ACCORDED EACH OFFICIAL FAX TRANSMISSION WILL BE DETERMINED BY THE FAX MACHINE DATE STAMP FOUND ON THE LAST PAGE OF THE TRANSMISSION, UNLESS THAT DATE IS A SATURDAY, SUNDAY, OR FEDERAL HOLIDAY WITHIN THE DISTRICT OF COLUMBIA, IN WHICH CASE THE OFFICIAL DATE OF RECEIPT WILL BE THE NEXT BUSINESS DAY.

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